

REMARKS

STATUS OF THE CLAIMS

Claims 1-8, 13-17, and 19-23 are pending in the application. Minor amendments to claims 1, 4, 5, 16, 20, and 21. These amendments are not for reasons related to patentability, but rather are to further distinguish the present invention from the cited references. Support for these amendments are to be found at least in paragraphs 18, 20, and 28 of the specification.

Accordingly, no new matter has been added by this amendment and no estoppels are intended thereby.

REJECTIONS UNDER 35 U.S.C. § 102(b) (U.S. Patent No. 5,656,368 to David L. Braun et al.)

Claims 1-4, 6-8 and 13-15 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,656,368 to David L. Braun et al. (the Braun et al. document). The Applicants believe that the amendment submitted herein to claim 1 resolves the foregoing rejection. Claims 2-4, 6-8, and 13-15 depend from independent claim 1. Therefore, withdrawal of the 35 U.S.C. § 102(b) rejection to claims 1-4, 6-8 and 13-15 as being anticipated by the Braun et al. document is respectfully requested in light of the amendments submitted herein and the following comments.

Claims 1 recites, *inter alia*, a multilayer composite filter medium for serial filtration of an oil, the filter medium having an onflow side and an outflow side with respect to a flow of the oil to be filtered, the filter medium comprising at least two filter layers, a first filter layer of the at least two filter layers having a particle retention size of 60µm and greater, a second filter layer of the at least two filter layers having a particle retention size of 10 to 60µm. In contrast: firstly, the

Braun et al. document is directed to an air filter and insulation for a garment (See Abstract). As such, the design and material characteristics of the filter medium disclosed in the Braun et al. document are completely inadequate to filter oil. Secondly, the non-woven filter medium disclosed in the Braun et al. document is the only filtering medium of the disclosed device. This is evidenced by the disclosure of the second layer as a, “shape retaining means 60.” In addition, even if it is assumed that the shape retaining means 60 does serve as a filtering medium, which it does not, the shape retaining means 60 does not hinder flow through the composite structure 10 to a significant extent (see Col. 9, lines 65 and 66). As such, no regard to the pore size of the shape retaining means 60 is given and therefore, no one would utilize the Braun et al. document to teach composite filter construction. Thirdly, the device disclosed in the Braun et al. document is a face mask (see abstract, FIGS 3 and 5, Col. 10, lines 46-51 and throughout disclosure). As such, the disclosed device experiences air flow in one direction during inhalation of a wearer and another direction during exhalation of the wearer. As such, the disclosed filtering device does not have an onflow side and an outflow side.

In view of the foregoing, withdrawal of the 35 U.S.C. § 102(b) rejection to claim 1 as being anticipated by the Braun et al. document is respectfully requested at least because the Braun et al. document fails to disclose a multilayer composite filter medium for serial filtration of an oil, the filter medium having an onflow side and an outflow side with respect to a flow of the oil to be filtered, the filter medium comprising at least two filter layers, a first filter layer of the at least two filter layers having a particle retention size of 60 μ m and greater, a second filter layer of the at least two filter layers having a particle retention size of 10 to 60 μ m. Claims 2-4, 6-8 and 13-15 depend from independent claim 1. Therefore it is respectfully submitted that claims 2-4, 6-8 and 13-15 are patentable for at least the same reasons as discussed in response to

the rejection of claim 1 as being anticipated by the Braun et al. document. In light of the foregoing, withdrawal of the 35 U.S.C. § 102(b) rejection of claims 2-4, 6-8 and 13-15 as being anticipated by the Braun et al. document is respectfully requested.

REJECTIONS UNDER 35 U.S.C. § 103(a) (Braun et al. and U.S. Patent No. 6,056,809 to Chapman)

Claims 5 and 16-23 stand rejected under 35 U.S.C. § 103(a) as being anticipated by the Braun et al. document in view of U.S. Patent No. 6,056,809 to Rick L. Chapman (the Chapman document). The Applicants believe that the amendments submitted herein to claims 1 and 16 resolve the foregoing rejection. Claim 5 depends from independent claim 1. Claims 17-23 depend from independent claim 16. Therefore, withdrawal of the 35 U.S.C. § 103(a) rejection to claims 5 and 16-23 as being anticipated by the Braun et al. document in view of the Chapman document is respectfully requested in light of the amendments submitted herein and the following comments.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge already available to one of ordinary skill in the art, to modify the reference or to combine the reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all of the claimed limitations. See MPEP § 2143.

In rejecting claims under 35 U.S.C. §103, and Examiner bears an initial burden of presenting a *prima facie* case of obviousness. A *prima facie* case of obviousness is established only if the teachings of the prior art would have suggested the claimed subject matter to a person

of ordinary skill in the art. If an Examiner fails to establish a *prima facie* case, the rejection is improper and will be overturned. See *In re Rijckaert*, 9 F.3d 1531, 28 U.S.P.Q. 2d 1955 (Fed. Cir. 1993). “If examination ... does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to the grant of the patent.” *In re Oetiker*, 977 f.2d 1443, 1445-1446, 24 U.S.P.Q. 2d 1443, 1444 (Fed. Cir. 1992).

A *prima facie* case of obviousness has not been made in that the combination of the Braun et al. document in view of the Chapman document fails to teach or suggest the invention as recited in claims 5 and 16-23 of the present application.

Claim 5 recites, *inter alia*, a multilayer composite filter medium for serial filtration of an oil, the filter medium having an onflow side and an outflow side with respect to a flow of the oil to be filtered, the filter medium comprising at least two filter layers, a first filter layer of the at least two filter layers having a particle retention size of 60 μ m and greater, a second filter layer of the at least two filter layers having a particle retention size of 10 to 60 μ m. As described herein, the Braun et al. document fails to disclose an oil filtering medium, fails to disclose a filter medium having two filtering layers, and fails to disclose a filter having an onflow side and an outflow side. The Chapman document fails to make up for the deficiencies of the Braun et al. document. In this regard, the Chapman document at least also fails to disclose an oil filter. Instead, the Chapman document discloses an air filter for filtering particles in the 0.3 μ m to 10 μ m range and having two electrostatic filtering elements (See Abstract). Such a filter is unsuitable for use as an oil filter at least because electrostatic elements are ineffective in a liquid environment and because the particle retention size is too small. In this regard and as is stated in M.P.E.P. 706.02(j), “To establish a *prima facie* case of obviousness . . . the prior art reference (or references when combined) must teach or suggest all the claim limitations.” As, neither the

Braun et al. document nor the Chapman document taken alone or in combination disclose a multilayer composite filter medium for serial filtration of an oil, the filter medium having an onflow side and an outflow side with respect to a flow of the oil to be filtered, the filter medium comprising at least two filter layers, a first filter layer of the at least two filter layers having a particle retention size of 60µm and greater, a second filter layer of the at least two filter layers having a particle retention size of 10 to 60µm, it is respectfully submitted that a *prima facie* case of obviousness has not been established. Therefore, the Applicants respectfully request the withdrawal of the rejection under 35 U.S.C. § 103(a) to claim 5.

Similarly, with respect to the rejection of claims 16-23, claim 16 recites, *inter alia*, a multilayer composite filter for serial filtration of a transmission fluid, the multilayer composite filter having an onflow side and an outflow side with respect to the fluid to be filtered, the composite filter comprising a first filter layer comprising a nonwoven mat, the first filter layer having a first edge, a first surface, and a second surface, wherein the first filter layer having a particle retention size of 60µm and greater. As described herein, both the Braun et al. document, and the Chapman document disclose air filters that are unsuitable for use as oil filters. As the primary constituent of transmission fluid is oil, neither the Braun et al. document, nor the Chapman document taken alone or in combination, disclose a multilayer composite filter for serial filtration of a transmission fluid. As such, it is respectfully submitted that a *prima facie* case of obviousness has not been established. Therefore, the Applicants respectfully request the withdrawal of the rejection under 35 U.S.C. § 103(a) to claims 16-23.

CONCLUSION

It is respectfully submitted that the application is now in condition for allowance. If it is believed that any further issue exists, the Examiner is invited to contact the undersigned agent by telephone if it is believed that such contact will expedite the prosecution of the application.

In the event this response is not timely received or an extension is required, the Applicants petition for an appropriate extension of time. Any additional fees may be charged to or overpayment credited to Deposit Account No. 50-2036.

Respectfully submitted,

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